Pellegrino, Rachel

From: Morris, Craig
Sent: Tuesday, January 04, 2011 5:22 PM
To: Brown, Brian (TM)
Subject: FW: Small Business Study
Attachments: REPLY TO REQUEST FOR COMMENTS 12-23-2010.doc

From: trademark@fancaster.com (b)(6)
Sent: Thursday, December 23, 2010 7:24 PM
To: TMFeedback
Subject: Small Business Study

REPLY TO REQUEST FOR COMMENTS: TRADEMARK LITIGATION TACTICS

December 23, 2010

In connection with the study described within The Trademark Technical and Conforming Amendment Act of 2010 which became effective on March 17, 2010. Pub. L. No. 111-146, 124 Stat. 66 (2010). , this reply to the USPTO is feedback from U.S. trademark owner Fancaster, Inc. and Craig Krueger regarding experiences with litigation tactics, especially those involving an attempt to enforce trademark rights beyond a reasonable interpretation of the scope of the rights granted to the trademark owner.

1) We are a trademark owner and a South Dakota corporation headquartered in New Jersey. We own, have owned, or have applied for less than a dozen trademarks over the past 20+ years.

2) In the past 5 years, we filed a trademark enforcement action in the District of New Jersey against Comcast et al, the largest cable provider in the United States concerning our incontestable trademark for *FANCASTER*. In retaliation, Defendant Comcast et al filed cancellation actions for two other trademarks: *Target Wireless* and *Mobile Voter* in a deliberate effort to drive up litigation costs. Comcast has no marks similar to *Target Wireless* or *Mobile Voter* and no business interests in ongoing registration of these marks.

3) We have not received a cease and desist letter at any time

4) We have been in litigation concerning the *FANCASTER* Mark in Federal Court in the District of New Jersey since June, 2008. The matter has not yet been fully adjudicated and new discovery is pending.

5) We have been and are still engaged in opposition to cancellation actions at the TTAB including the following Marks: *FANCASTER* (suspended in lieu of action in Federal Court), *TARGET WIRELESS* (Cancellation Number: 92051554), and *MOBILE VOTER* (Cancellation Number: 92051553). We subsequently voluntarily surrendered the registration for the *Mobile Voter* Mark. The latter two cancellation actions were filed after we filed an action for Trademark Infringement against Comcast et al. in June, 2008. Comcast has no marks similar to *Target Wireless* or *Mobile Voter* and no business interests in ongoing registration of these marks.

6) Trademark bullies are clearly a problem and should be stopped. Due to the financial cost of defending cancellation actions by trademark bullies, including cancellation actions that are without merit, small companies and individuals are placed in a difficult position where surrender of valid trademarks that are being lawfully used is the only rational financially-feasible option available. We have already surrendered our *MOBILE VOTER* Trademark registration and now face the same inequitable dilemma concerning the cancellation action filed by Comcast et al concerning the incontestable *TARGET WIRELESS* Mark.

7) Aggressive litigation tactics appear to be more pervasive in the trademark area than in other areas of the law.

8) The USPTO has a responsibility to do something to discourage or prevent trademark bullying. For a multi-billion dollar conglomerate such as Comcast, money damages may not be enough. Counsel who employs bullying tactics should be held accountable for such conduct by being subject to (1) Publication of their identities and their firm's identities and address, (2) subject to fines and for repeated offenders, (3) subject to suspension from practice before the TTAB.

9) US Courts should immediately issue Stays to trademark cancellation actions filed by trademark bullies. US Courts should hear Interlocutory appeals for Motions to Dismiss and stay all trademark cancellation actions filed by trademark bullies until such interlocutory appeals are fully adjudicated by the Courts.

10) Other agencies that should investigate bullying tactics should include the: Federal Trade Commission, The Federal Communications Commission, Department of Justice, State Bars, State Attorney Generals, and the Federal Bar.

11) Congress should enact legislation to deter conduct that is identified and legally defined as "bullying" by levying sanctions and monetary fines against parties and their counsel who are found to employ such conduct. Further, for repeated offenders, Congress should consider suspension of counsel and their law firms from practice before the TTAB.

12) The USPTO should also add a page to their website identifying firms and counsel who have been found to employ "bullying" tactics and force all counsel in all subsequent pleadings and appearances before the TTAB to disclose trademark bullying counsel's name, address, and law firm name and address and require this continued disclosure for a reasonable period of time to deter such "bullying" conduct in the future.

Respectfully Submitted,

Craig Krueger

President, Fancaster Inc.

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